

REMARKS

I. Introduction

Claims 40-41, 46-48 and 53 stand rejected under 35 U.S.C. § 102.

Claims 18, 42, 45, 49, and 52 stand rejected under 35 U.S.C. §103(a).

Claims 40 and 47 are independent claims.

II. Amendments

Claim 40 has been amended to incorporate the limitations of dependent claims 43 and 44. Claim 47 has been amended to incorporate the limitations of dependent claims 50 and 51. Claims 43, 44, 50 and 51 have been canceled without prejudice or disclaimer. No new matter has been added.

III. Prior Art Rejections

A. The Claims Are Not Anticipated

Claims 40-41, 46-48 and 53 stand rejected under 35 U.S.C. §102 as being anticipated by Smith et al. (U.S. Pat. No. 5,995,942).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

The Office action acknowledges that Smith “does not show identifying the detected promotion as a valid promotion if it has not already been presented” in discussing former claims

43-44 and 50-51. Claim 40 has been amended to incorporate the limitations of dependent claims 43 and 44, and claim 47 has been amended to incorporate the limitations of dependent claims 50 and 51. Accordingly, Smith does not disclose each and every element of amended claims 40 and 47, and hence does not anticipate amended claims 40 and 47. Smith also does not anticipate claims 41 and 46 which depend on claim 40 and incorporate all the limitations thereof. Likewise, Smith does not anticipate claims 48 and 53 which depend on claim 47 and incorporate all of the limitations thereof.

B. The Claims Are Not Obvious

1. Former claims 43-44 and 50-51, which have been incorporated into claims 40 and 47 respectively, were rejected under 35 U.S.C. §103 as being unpatentable over Smith in view of Day (U.S. Pat. No. 6,484,146).¹

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

¹ Applicants note that prior claims 43 and 44 depended on claim 42, and claims 50 and 51 depended on claim 49 which were rejected under the combination of DeLapa and Smith, i.e. requiring the disclosure of DeLapa as the primary reference for rejecting claims 42 and 49. However, DeLapa was not relied on for the rejection of former claims 43, 44, 50 and 51, and Smith, which was the secondary reference, was relied on as the primary reference. Accordingly, the rejection of claims 43 and 44 clearly failed to establish a prima facie case of obviousness.

Neither Smith nor Day, taken alone or in combination, disclose or suggest a system or a method of providing promotions in which it is determined if a detected promotion on the promotion carrier has already been presented, and the promotion is identified as a valid promotion if it has not already been presented. As discussed above, these features were previously contained in claims 43, 44, 50 and 51 and have now been incorporated in amended claims 40 and 47. The Office action explains that Smith does not disclose a promotion carrier which incorporates such features as discussed above. Day discloses the use of a customer identification card to obtain the promotions. See, col. 4: 32-48. Day also does not disclose or suggest to use a promotion carrier which bears a plurality of offers for sale of a plurality of products which may be accessed by reading a single machine readable code, i.e. the card of Day does not carry promotions. Clearly, as Day does not even have a promotion on a promotion carrier, Day does not determine if a promotion on a promotion carrier is valid or not.

Accordingly, as neither Smith nor Day disclose all of the limitations of amended claims 40 or 47, the combination of Smith and Day does not render amended claims 40 or 47 as being unpatentable.

2. Claims 42, 45, 49 and 52 stand rejected under 35 U.S.C. §103 as being unpatentable over DeLapa et al. (U.S. Pat. 5,353,218) in view of Smith.

Neither DeLapa nor Smith, taken alone or in combination, disclose or suggest a system or a method of providing promotions in which it is determined if a detected promotion on the promotion carrier has already been presented, and identified the promotion as a valid promotion if it has not already been presented. As discussed above, these features were previously contained in claims 43, 44, 50 and 51 and have now been incorporated in amended claims 40 and

47. The Office action explains that Smith does not disclose a promotion carrier which incorporates such features in combination with other features recited in the claim. DeLapa also does not disclose such features, and the Examiner does not rely on DeLapa as disclosing such features.

Accordingly, as neither DeLapa nor Smith disclose all of the limitations of claims 42 and 45, which depend on amended claims 40 and incorporate all the limitations thereof, nor all of the limitations of claims 49 and 52, which depend on amended claim 47 and incorporate all the limitations thereof, the combination of Smith and Day does not render claims 42, 45, 49 or 52 as being unpatentable.

IV. Conclusion

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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